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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,671	03/29/2004	Veronika Hochstein	MERCK-2867	1160

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EXAMINER

MANLOVE, SHALIE A

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 06/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/810,671

Applicant(s)

HOCHSTEIN ET AL.

Examiner

Shalie A. Manlove

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

### **DETAILED ACTION**

A third-party submission has been filed under 37 CFR 1.99 on November 30, 2004 in the published application.

To ensure that a third-party submission does not amount to a protest or pre-grant opposition, 37 CFR 1.99 does not permit the third party to have the right to insist that the examiner consider any of the patents or publications submitted. Furthermore, if the submission or part of the submission is not in compliance with 37 CFR 1.99, that noncompliant submission or part thereof will not be entered in the application file. Therefore, unless the examiner clearly cites a patent or publication on form PTO-892, Notice of References Cited and such reference is used in a rejection or its relevance is actually discussed during prosecution, consideration by the examiner of any patent or publication submitted in a third-party submission cannot be presumed.

If the applicant wants to ensure that the information in a third-party submission is considered by the examiner, the applicant should submit the information in an IDS in compliance with 37 CFR 1.97 and 37 CFR 1.98. An individual who has a duty to disclose under 37 CFR 1.56 should also submit any material information contained in a third-party submission to the Office in an IDS in compliance with 37 CFR 1.97 and 37 CFR 1.98 to ensure such material information is properly disclosed to the examiner.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4, 7-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Pfaff et al US 6,517,628.

With respect to claim 1, Pfaff teaches a pigment mixture comprising two components, component A being a multilayer pigment based on glass flakes and component B being platelet-shaped, acicular or spherical colorants and or fillers (abstract, col. 1, lines 41-44; col. 2, lines 8-25).

As to claim 2, Pfaff teaches the pigment mixture wherein component B contains a colorant selected from a pearlescent, multilayered and interference pigments (col. 3, lines 4-17, 30-45).

As to claims 3 and 4, Pfaff teaches the pigment mixture has the following layer structures:

glass flake + Fe<sub>2</sub>O<sub>3</sub> layer + SiO<sub>2</sub> layer + Fe<sub>2</sub>O<sub>3</sub> layer;

glass flake + Fe<sub>2</sub>O<sub>3</sub> layer + SiO<sub>2</sub> layer + TiO<sub>2</sub> layer;

glass flake + TiO<sub>2</sub> layer + SiO<sub>2</sub> layer + Fe<sub>2</sub>O<sub>3</sub> layer;

glass flake + TiO<sub>2</sub> layer + SiO<sub>2</sub> layer + TiO<sub>2</sub>/Fe<sub>2</sub>O<sub>3</sub> layer;

glass flake + TiO<sub>2</sub>/Fe<sub>2</sub>O<sub>3</sub> layer + SiO<sub>2</sub> layer + TiO<sub>2</sub>/Fe<sub>2</sub>O<sub>3</sub> layer; or

glass flake + TiO<sub>2</sub> layer + SiO<sub>2</sub> layer + Cr<sub>2</sub>O<sub>3</sub> layer. (col. 2, lines 30-35 and col. 3, lines 4-17, 30-45).

As to claims 7, 8, 9 and 11, Pfaff teaches in examples 4-7 a pigment mixture additionally comprising at least one additive, which is conventional in cosmetics (col. 6, lines 10-col. 7 line 55).

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As to claim 10, Pfaff teaches the pigment mixture wherein component A and component B are mixed in a weight ratio of from 1:20 to about 20:1 (col. 1, lines 61-63).

3. Claims 1-9, and 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Anselmann et al WO 02/090448.

With respect to claim 1, Anselmann teaches a pigment mixture comprising two components, a first component being an effect pigment based on glass flakes and a second component being black organic or inorganic luster, conventional transparent, organic or inorganic colorants and or fillers (page 6 lines 21 – page 7, line 6).

As to claim 2, Anselmann teaches a second component to be comprised of black organic or inorganic luster, conventional transparent, organic or inorganic colorants and or fillers (page 6 lines 21 – page 7, line 6).

As to claims 3 and 4, Anselmann teaches the pigment mixture has the following layer structures:

glass flake + TiO<sub>2</sub> layer;

glass flake + Fe<sub>2</sub>O<sub>3</sub> layer;

glass flake + Fe<sub>3</sub>O<sub>4</sub> layer;

glass flake + TiFe<sub>2</sub>O<sub>3</sub> layer;

glass flake + Cr<sub>2</sub>O<sub>3</sub> layer; (page 5, lines 30-35)

As to claim 5 and 6, Anselmann teaches the first component which is based on a glass flake wherein the glass flake has a layer thickness of less than or equal to 1 micron (page 3, line 25).

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As to claims 7-9 and 11-13, Anselmann teaches a pigment mixture additionally comprising at least one additive, which is conventional in cosmetics, food, and medicaments (page 7, lines 14-17). The reference implies and inherently teaches formulations employing the claimed pigment for use in cosmetic, food, and medicament applications.

4. Claims 1-9, and 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Ambrosius et al WO 03/006558.

With respect to claim 1, Ambrosius teaches a pigment mixture comprising two components, a first component being an effect pigment based on glass flakes and a second component being black organic or inorganic luster, conventional transparent, organic or inorganic colorants and or fillers (page 14 lines 30 – page 15, line 7).

As to claim 2, Ambrosius teaches a second component to be comprised of black organic or inorganic luster, conventional transparent, organic or inorganic colorants and or fillers (page 14 lines 30 – page 15, line 7).

As to claims 3 and 4, Ambrosius teaches the pigment mixture has the following layer structures:

glass flake + Fe<sub>2</sub>O<sub>3</sub> layer + SiO<sub>2</sub> layer + Fe<sub>2</sub>O<sub>3</sub> layer;

glass flake + Fe<sub>2</sub>O<sub>3</sub> layer + SiO<sub>2</sub> layer + TiO<sub>2</sub> layer;

glass flake + TiO<sub>2</sub> layer + SiO<sub>2</sub> layer + Fe<sub>2</sub>O<sub>3</sub> layer;

glass flake + TiO<sub>2</sub> layer + SiO<sub>2</sub> layer + TiO<sub>2</sub>/Fe<sub>2</sub>O<sub>3</sub> layer;

glass flake + TiO<sub>2</sub>/Fe<sub>2</sub>O<sub>3</sub> layer + SiO<sub>2</sub> layer + TiO<sub>2</sub>/Fe<sub>2</sub>O<sub>3</sub> layer; or

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glass flake + TiO<sub>2</sub> layer + SiO<sub>2</sub> layer + Cr<sub>2</sub>O<sub>3</sub> layer. (page 9, line 25-page 10, line 10).

As to claim 5 and 6, Ambrosius teaches the first component which is based on a glass flake wherein the glass flake has a layer thickness of less than or equal to 1 micron (page 5, line 20).

As to claims 7-9 and 11-13, Ambrosius teaches a pigment mixture additionally comprising at least one additive, which is conventional in cosmetics, food, and medicaments (page 15, lines 15-19). The reference implies and inherently teaches formulations employing the claimed pigment for use in cosmetic, food, and medicament applications.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Anselmann et al WO 02/090448.

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As to claim 10, Anselmann teaches the pigment mixture wherein the first component and second component are mixed in a weight ratio of from 0.01- 50% (page 7, lines 17-23). The reference teaches overlapping ranges of the weight ratio.

A prima facie case of obviousness typically exists when the range of a claimed composition overlaps the ranges disclosed in the prior art. *In re Malagari*, 499 F.2d 1297, 1303, 182 USPQ 549, 553 (CCPA 1974)

8. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ambrosius et al WO 02/090448.

As to claim 10, Ambrosius teaches the pigment mixture wherein the first component and second component are mixed in a weight ratio of from 0.01- 50% (page 15, lines 19-23). The reference teaches overlapping ranges of the weight ratio.

A prima facie case of obviousness typically exists when the range of a claimed composition overlaps the ranges disclosed in the prior art. *In re Malagari*, 499 F.2d 1297, 1303, 182 USPQ 549, 553 (CCPA 1974)

### ***Double Patenting***

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).



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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claim rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims

11. Claims 1-9, and 11-13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6, 8, 11, 14-18 of U.S. Patent No. US 6,517,628. Although the conflicting claims are not identical, they are not patentably distinct from each other because the reference and the application teach similar pigment mixtures comprising an effect pigment based on glass flakes admixed to a pearlescent, multilayer, or interference pigment.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shalie A. Manlove whose telephone number is (571) 272-1372. The examiner can normally be reached on M-TH 6:30-4:30 pm.

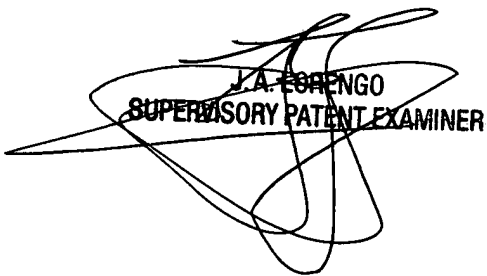
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shalie A. Manlove  
Examiner  
Art Unit 1755

June 13, 2005

  
J.A. FORENGO  
SUPERVISORY PATENT EXAMINER